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In the United States Patent Office

William E. McLaughlin

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Division of 09/235.618 filed Jan.21,1999, allowed, issue fee paid, in Publications

Group 3713, Assistant Examiner A. Rade, phone 703-308-7135

Class 473/353.000

Southampton, PA 18966-4545

July 31, 2002

Commissioner of Patents, Washington, DC 20231 – Box Amendments no fee

SUMMARY OF TELEPHONE CONVERSATION

The inventor, now in his '80s and retired, was a successful real estate broker and real estate appraiser. Thus he became well informed about some aspects of real estate law. His dad and brother were lawyers. He had no occasion to deal with patent law until the filing of the ancestral case in 1999. , He had decades of dealing with zoning commissions, boards of supervisors, recorders of deeds, and other governmental offices pertinent to real estate. The inventor has had difficulty in learning how different the Patent Office is from the governmental bureaus with which he dealt. Thus counsel, an 86 year old who became acquainted with the inventor more than 50 years ago, has been induced to seek to expedite the issuance of the two applications. This included a telephone conversation with Examiner Rade on Wednesday afternoon, July 31, 2002. This document confirms that during such phone conversation, Counsel made not effort to obtain any agreement concerning the case. The Examiner said little. Counsel sought to clarify why this divisional case differs from many divisional cases. It resembles some divisional cases in that the evidence submitted in the parent case is relevant to this case. Copies of such

evidence from the parent case are scheduled to be submitted herein promptly now that an Examiner and class have been assigned to the divisional application. The data submitted in the ancestor case are extremely pertinent to the apparatus claims sought in the present case. This communication alerts the Examiner to expect such evidence of patentability in the near future. Counsel understands that Examiner Rade has not thus far reached this case. Even with the delays currently occurring within the Patent Office, there is reason for hoping that such evidence can be made of record in this case prior to the Examiner's first examination thereof, thereby increasing the hope for a First Action Allowance. In allowing this case, the "Reasons for Allowance" can be quite similar to those in the parent case.

In the telephone conversation, Counsel was primarily concerned with explaining why this is an unusual divisional application. Counsel is fully convinced that the arguments made in the ancestor cases provide a more than adequate basis for the allowance of the apparatus claims sought herein.

The present examiner should desirably have at least some perspective on the history of the parent case, or ancestor cases, depending upon whether the CPA [not having a different serial number, but costing applicant an additional filing fee] is treated as an additional case.

The grandparent application as filed in 1999 contained both method claims 1, 2, 6, and 7 and apparatus claims 3, 4, and 5. Appropriate amendments and renumbering led to the method claims allowed September 7, 2001 in the CPA application. The issue fee for such [CPA] parent application was mailed by first class claim on Nov. 2, 2001, such application being now in

the publications division after the granting of a Petition to Revive on July 19, 2002. This is a divisional case because the currently sought apparatus claims benefit from the Jan. 21,1999 filing date of the grandparent case.

Counsel deemed this to be a single invention best described with hybrid claims containing both process and apparatus limitations. Examiner Dr. Sean Smith did not make any restriction requirement between the method claims and apparatus claims, but rejected them as if both types of claims defined the same invention. Some such papers [rejections and responses] were dated: Nov. 3 1999;applicant's Response of Jan 7, 2000;Rejection of April 11, 2000;Response of June 12, 2000; supplemental amendment of September 22, 2000; rejection of Dec. 6, 2000; and the Response [Express Mail] Jan.2, 2001. It was after three rejections and about five responses that surprisingly, in a FINAL rejection of April 10, 2001 the Examiner made a restriction requirement between the method and apparatus claims, combined with an erroneous assertion that Applicant had elected method claims when in fact applicant had consistently argued for the allowability of both apparatus claims and method claims. Counsel argued against such restriction requirement and insisted that there had not been an election in the amendment filed about May 18, 2001, after an interview with Examiner Smith on May 9, 2001. As a result of an Advisory action of May 31, 2001, a CPA application was filed by FAX on about June 6, 2001. Counsel again submitted arguments that there had been no election, and that the restriction requirement was contrary to MPEP, etc. In a telephone conversation on Aug. 8, 2001 with Examiner Smith, counsel learned that for a second time, all of counsel's arguments about the

unity of the invention, the absence of any election, etc. were being rejected, and that the Examiner's contention that a second filing fee for the apparatus claims was necessary seemed to require, at that late date, capitulation.

Hence, the apparatus claims were submitted in a divisional application filed to the brand new FAX number assigned to Examiner Smith. Counsel was under the impression that this divisional case would have the benefit of the August 9, 2001 date on which the attempt was made to file this application by FAXing, analogous to the filing of a CPA application. Counsel employed his Washington Associate, Eric Scherlin, to obtain the data for confirming applicant's entitlement to the Aug. 9, 2002 filing date for this case in October, 2001 after discovering that the Patent Office, although it accepts a CPA case by FAXing, does not accept a divisional case by FAXing.

The last set of good drawings were included when this case was filed on Saturday, Nov. 2, 2002, thus creating a series of problems when the Anthrax sterilization damaged such drawings.

As a result of such capitulation of Aug. 9, 2001, the parent case containing the active method claims and dormant [scheduled for divisional application] apparatus claims, advanced to the issuance of a Notice of Allowability of the method claims on September 7, 2001.

Counsel prepared and Express Mailed this Divisional Application on November 2, 2001, concurrently with two first class mailings to the Commissioner of Patents. One of the first class mailings was the second maintenance fee for the Bigelow patent. The other was the payment of the issue fee for the parent case. In paying the issue fee, counsel used his Deposit Account 50-1224, and printed or signed his name twice on the form, but

inadvertently omitted a date and sign at that portion of the issue fee form constituting the Certificate of Mailing. During the sterilization for Anthrax, this application was damaged so badly that it was necessary to resubmit the application on March 3, even though there were troublesome problems in obtaining acceptable photocopies of the drawings. The maintenance fee postcard showed damage. The postal service lost the issue fee payment, leading to a Petition to Revive and a favorable decision on July 19, 2002.

At an earlier stage, counsel sought to establish applicant's right to a filing date of August 9, 2002 for this case. Prompt issuance of this apparatus patent is now the objective. The Examiner recognizes that most divisional applications have not encountered some of the hurdles that previously troubled this case.

Thanks are extended to the Examiner for the telephone conversation of July 31, 2002.

Respectfully submitted,

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Certificate of Mailing

John R. Ewbank certifies that this was deposited in the US Postal Service on August 1, 2002 with first class postage addressed to CoP, Washington DC 20231 .....John R. Ewbank